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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,909	02/24/2004	Nadia Gardel	05725.1339-00	6147
22852	7590	10/13/2011		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER SOROUSH, ALI	
			ART UNIT	PAPER NUMBER
			1617	
			MAIL DATE	DELIVERY MODE
			10/13/2011 PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/784,909

Applicant(s)

GARDEL ET AL.

Examiner

ALI SOROUSH

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 80, 82, 83, 86-100, 104-125, 134, 135 and 139-186 is/are pending in the application.
- 5a) Of the above claim(s) 83 and 150-166 is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 80, 82, 86-100, 104-125, 134, 135, 139-149 and 167-186 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-940)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Continued Examination under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/05/2011 has been entered.

Claim Status

Claims 80, 82, 83, 86-100, 104-125, 134, 135, 139-149, and 150-186 are pending.

Claims 1-79, 81, 84, 85, 94-96, 101-103, 126-133, and 136-138 were previously cancelled.

Claims 83 and 150-166 are withdrawn as being directed to a non-elected invention.

Claims 80, 82, 86-100, 104-125, 134, 135, 139-149, and 167-186 have been examined.

Claims 80, 82, 86-100, 104-125, 134, 135, 139-149, 167-186 are rejected.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 80, 82, 84-149 and 167-186 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12, 15 and 18-99 of U.S. Patent No. 10/603,698. Although the conflicting claims are not identical, they are not patentably distinct from each other because both copending applications are directed to a water-in-oil foundation comprising at least one oil, an aqueous phase, a copolyol and a coloring material. The difference between the instant invention and the copending application is the weight percentages and concentrations of the components. This determination would have been made through routine experimentation to achieve the desired results of the claimed invention. This is in the absence of any clear showing

of unexpected results attributable to the specific concentrations of the components employed by applicant in the instant case.

Response to Arguments

Applicants request that the examiner holds the rejection in abeyance until there is an indication of allowable subject matter. The examiner can grant this request, the double patenting rejection is maintained and a terminal disclaimer is required to overcome the rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 80, 82, 86-93, 97-100, 104-149, and 167-186 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanna et al. (US Patent 5843417, Published 12/01/1998) in view of Bara et al. (US Patent 5902592, Published 05/11/1999).

The claims are directed to a water-in-oil foundation comprising at least one volatile hydrocarbon-based oil, at least a first volatile silicone oil, at least a second volatile silicone oil, at least 8% by weight dyestuff, and an aqueous phase containing water, a first miscible polyol comprising 3 carbon atoms being present in an amount ranging from 5 to 8% by weight of the total composition and a second water miscible polyol comprising between 4 to 6 carbon atoms being present in an amount ranging from 1 to 7% by weight of the total composition.

Hanna et al. disclose a water-in-oil emulsion make-up composition comprising 5% coated iron oxide particles (dyestuff), 8% coated titanium oxide particles (dyestuff), 22% isododecane (volatile hydrocarbon based oil), cetyl diemthicone copolyol, 4% propylene glycol (polyol comprising 3 carbons), and water qs to 100% (column 7,

example). The makeup composition comprises moisturizers such as propylene glycol which can be present in amounts including 0.1-10% (column 6, lines 25-32). The composition can further comprise water-soluble or water-dispersible polymers such as polymethylmethacrylate in amounts of 0.1 to 10% (column 5, lines 34-46). The composition can also further include volatile silicone oils in order to achieve a desired feel and behavior of the composition (column 3, lines 33-43).

Hanna et al. do not teach the specific volatile silicone oils as claimed by applicant. Hanna et al. further lacks a second polyol comprising 4 to 6 carbons and being present in an amount of 1 to 7%.

Bara et al. teach a cosmetic composition comprising 2-18% cyclopentadimethylsiloxane and 2-18% cyclohexadimethylsiloxane composition (abstract and column 1, lines 54-56). Bara et al. further teach that addition of cyclopentadimethylsiloxane provides the cosmetic with the ability to be more easily applied to the skin and that the addition of cyclohexadimethylsiloxane gives the cosmetic a more comfortable feeling and further prevents the skin tightness and dry feeling (column 1, lines 57-65). The preferred composition has an aqueous phase comprising 5% polyethylene glycol (4 carbon polyol) and 3% propylene glycol (column 5, Lines 20-40).

It would have been prima facie obvious to one of ordinary skill in the art at the time of the instant invention to combine the teachings of Hanna et al. with Bara et al. One would have been motivated to do so in order to adjust the feel and behavior of the cosmetic composition on the skin it is being applied to. One would have expected

success since Hanna et al. and Bara et al. teach oil-in-water cosmetic composition for topical application. With regard to the instant concentration of polyol it would have been obvious to one of ordinary skill in the art to adjust the concentration of the propylene glycol to the instantly claimed concentration in order to achieve the proper moisturizing effect desired since the instant concentrations overlap with the concentrations taught by Hanna et al.

Response to Applicant's Arguments

Applicant argues that Bara et al. does not teach or suggest the polyols instantly claimed. Applicant's argument has been fully considered but found not to be persuasive. Bara et al. teach that the preferred composition comprises polyethylene glycol (4 carbon polyol) and 3% propylene glycol (column 5, Lines 20-40), which reads on instantly claimed polyols.

Applicant further argues that there is no motivation to combine the water-in-oil composition of Bara et al. with Hanna et al. Applicant's argument has been fully considered and found not to be persuasive. It would have been prima facie obvious to one of ordinary skill in the art to combine the compositions of Bara et al. and Hanna et al. to achieve a composition that is more easily applied to the skin (column 1, lines 57-65) and arrive at the instantly claimed composition. Since both compositions are water-in-oil emulsions for application to the skin, one of ordinary skill in the art at the time of the instant invention would have had an expectation of success in combining the two compositions.

Declaration under 37 CFR 1.132 (Unexpected Success)

Applicant has provided and argued that they have found unexpectedly that the instant composition results in a rapid and easy application with improved glide of the cosmetic. Applicant's declaration has been fully considered but found not to be persuasive. Applicant data is a subjective analysis of user preference. Therefore the data is only a difference in degree which has very little meaning in a relevant legal sense. *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992). The evidence relied upon should establish "that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance." *Id.* The data provided by applicant has not been shown to be of statistical significance. Furthermore, since Bara et al. teach that addition of cyclopentadimethylsiloxane provides the cosmetic with the ability to be more easily applied to the skin, it would not have been unexpected that the instant composition comprising cyclopentadimethylsiloxane would result in the rapid and easy application with improved glide of the cosmetic. For the foregoing reasons the instant claims are anticipated.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALI SOROUGH whose telephone number is (571)272-9925. The examiner can normally be reached on M-F (9am-6pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fereydown G. Sajjadi can be reached on (571)272-3311. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ALI SOROUSH/
Examiner, Art Unit 1617

October 10, 2011